

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte DALE K. WHEELER, ROBERT G. MOORES, JR.,  
and  
RICHARD T. WALTER

---

Appeal No. 2001-0119  
Application No. 09/281,870

---

ON BRIEF

---

Before KIMLIN, DELMENDO, and PAWLIKOWSKI, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 68 through 99, which are all of the claims pending in the above-identified application.<sup>1</sup>

The subject matter on appeal relates to a cordless (battery-operated) device such as a power tool or kitchen appliance.

(Specification, page 1, lines 7-9.) Further details of this

---

<sup>1</sup> The appellants canceled claims 1-67 in the preliminary amendment filed on Mar. 31, 1999 (paper 2). We note, however, that the amendment has not been clerically entered. In the event of further prosecution, we trust that the examiner will attend to this matter.

appealed subject matter are recited in illustrative claim 68 reproduced below:

68. A cordless device comprising:  
a housing;  
a cavity within said housing;  
a receptacle disposed in said cavity;  
a battery pack electrically connected to the  
receptacle, the battery pack comprising:  
a cell;  
a casing carrying the cell and having a front end;  
and  
a retaining means disposed at the front end of the  
casing for retaining the cell within the casing;  
wherein at least one of the receptacle and the  
battery pack have a first round terminal, and the other  
of the receptacle and the battery pack have a first  
connecting terminal for contacting the first round  
terminal; and  
at least one of the receptacle and the battery  
pack have a second round terminal, and the other of the  
receptacle and the battery pack have a second  
connecting terminal for contacting the second round  
terminal;  
said first round terminal and first connecting  
terminals and said second round terminal and second  
connecting terminal being matable in any angular  
orientation of the battery pack.

The examiner relies on the following United States patent as  
evidence of unpatentability:

Wheeler et al.	5,489,484	Feb. 6, 1996
(Wheeler)		

Claims 68 through 99 on appeal stand rejected under the  
judicially created doctrine of obviousness-type double patenting  
as unpatentable over claims 32 through 46, 56 through 63, 66  
through 68, and 71 through 75 of the Wheeler patent. (Examiner's  
answer, pages 3-5.)

We affirm this rejection based on the examiner's cogent and well-reasoned analysis.

The appellants concede that the examiner's double patenting rejection has substantive merit. (Appeal brief filed Feb. 16, 2000, paper 7, page 10.) The appellants further admit that no terminal disclaimer, much less a terminal disclaimer in compliance with 37 CFR § 1.321 (1996), has been filed in the present application.

Under these circumstances, we must uphold the examiner's rejection because the appellants (1) failed to rebut the examiner's prima facie case of obviousness-type double patenting with any argument and/or evidence in support of nonobviousness and (2) failed to file any terminal disclaimer.

The appellants' posture in this appeal is that only a limited terminal disclaimer (i.e., a terminal disclaimer that does not include a disclaimer of any portion of the term of any patent issuing from the present application) should be necessary to obviate the examiner's obviousness-type double patenting rejection because, under 35 U.S.C. § 154(a)(2)(2002), any patent issuing from the present application will necessarily expire on the same day as the Wheeler patent. (Appeal brief, pages 10-15.) We decline, however, to issue an advisory opinion based on hypothetical facts not properly before us. As we discussed

above, no terminal disclaimer has been filed in this case. Accordingly, there is no need for us to decide whether a hypothetical "limited terminal disclaimer" would be sufficient to overcome the examiner's rejection or, for that matter, decide whether we even have any authority to invalidate a regulation promulgated by the Director through proper rulemaking procedures.

For these reasons and those set forth in the answer, we affirm the examiner's rejection under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 32 through 46, 56 through 63, 66 through 68, and 71 through 75 of the Wheeler patent.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Appeal No. 2001-0119  
Application No. 09/281,870

Edward C. Kimlin	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF
	)	PATENT
Romulo H. Delmendo	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
	)	
Beverly A. Pawlikowski	)	
Administrative Patent Judge	)	

rhhd/

ADAN ALAYA  
THE BLACK AND DECKER CORPORATION  
701 EAST JOPPA RD  
TOWSON MD 21286